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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,295	08/27/2001	Samuel Anderson	36-1481	4008

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EXAMINER	
FRENEL, VANEL	
ART UNIT	PAPER NUMBER
3687	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/914,295	ANDERSON ET AL.	
	Examiner	Art Unit	
	VANEL FRENEL	3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/30/08*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the request for reconsideration filed on 10/30/08. Claims 1-5 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy et al. (5,287,270) in view of Cool (5,218,632).

As per claim 1, Hardy discloses a method of editing an electronic bill image having an appearance associated therewith, the electronic bill image having a number of records (See Hardy, Col.8, lines 63-68), the electronic bill image being stored in a computer implemented billing system, each record having an assigned charge type identifier (CTI) stored in the computer implemented billing system (See Hardy, Fig.1; Col. 8, lines 55-68 to Col.9, line 16).

Hardy does not explicitly disclose that the method having a format of the appearance of the electronic bill image being dependent on the CTIs of the respective records, the method including the steps of establishing a set of data structures, converting each record of the bill image into a record held in one or more of the data

structures in dependence on the CTI of the respective bill image record, editing one or more of the records held in the data structures, and using the records held in the data structures to create a new electronic bill image, the new electronic bill image having a new appearance.

However, this feature is known in the art, as evidenced by Cool. In particular, Cool suggests that the method having a format of the appearance of the electronic bill image being dependent on the CTIs of the respective records, the method including the steps of establishing a set of data structures, converting each record of the bill image into a record held in one or more of the data structures in dependence on the CTI of the respective bill image record, editing one or more of the records held in the data structures, and using the records held in the data structures to create a new electronic bill image, the new electronic bill image having a new appearance (See Cool, Col.5, lines 16-63; Co1.13, lines 37-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Cool within the system of Hardy with the motivation of providing a billing record within the charging system of a stored program controlled communications exchange operated by a telecommunications administration in which charging analysis is performed on each call and data and pointers to first and second locations are produced based upon the type of call (See Cool, Col .3, lines 29-34).

As per claim 2, Cool discloses a method comprising the further step of processing each record held in the data structures in dependence on its assigned CTI to create the new electronic bill image, the format of the appearance of the new electronic bill image being dependent on the CTIs of the records (See Cool, Col.5, lines 16-63). The motivation for combining the respective teachings of Hardy and Cool are as discussed in the rejection of claim 1 above, and incorporated herein.

As per claim 3, Cool discloses a method in which each record of the electronic bill image relates to one of a group consisting of a call charge (See Cool, Fig.8; Col.9, lines 55-68).

The motivation for combining the respective teachings of Hardy and Cool are as discussed in the rejection of claim 1 above, and incorporated herein.

As per claim 4, Hardy discloses a computer implemented bill image editor comprising: at least one computer readable memory storing computer executable instructions for performing the method of a selective one of claims 1 to 3 (See Hardy, Col.7, lines 11-54).

As per claim 5, Hardy discloses a computer implemented electronic bill image editing system for editing an electronic bill image having an appearance associated therewith, the system comprising: means for establishing a set of data structures (See Hardy, Col.8, lines 63-68); means for converting each record of an electronic bill image

into a record held in one or more of the data structures in dependence on an assigned charge type identifier of a respective bill image record (See Hardy, Fig..1; Col. 8, lines 55-68 to Col.9, line 16).

Cool does not explicitly disclose that the system having means for editing of one or more of the records held in the data structures; and, means for creating a new bill image using the records held in the data structures, the new electronic bill image having a new appearance.

However, this feature is known in the art, as evidenced by Cool. In particular, Cool suggests that the system having means for editing of one or more of the records held in the data structures; and create a new bill image using the records held in the data structures; and, means for creating new bill image using the records held in the data structures, the new electronic bill image having a new appearance (See Cool, Col.5, lines 16-63; Co1.13, lines 37-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Cool within the system of Hardy with the motivation of providing a billing record within the charging system of a stored program controlled communications exchange operated by a telecommunications administration in which charging analysis is performed on each call and data and pointers to first and second locations are produced based upon the type of call (See Cool, Col .3, lines 29-34).

Response to Arguments

4. Applicant's arguments filed 10/30/08 with respect to claims 1-5 have been fully considered but they are not persuasive.

(A) At pages 1-4 of the response filed on 10/30/08, Applicant's argues the followings:

(i) Hardy does not disclose "processing of a telephone bill image.

(ii) Cool does not disclose editing one or more records held in the data structures.

(iii) The cited art taken singly or in combination fails to render the present claims 1-5 obvious.

(B) With respect to Applicant's first argument, the Examiner respectfully submitted that He relied upon the clear teaching of Hardy (See Hardy, Fig.1; Col.2, line 67 to Col.3, line 33; Col.8, lines 63-68 to Col.9, line 16) which correspond to Applicant's claimed feature. Therefore, Applicant argument is not persuasive and the rejection is hereby sustained.

(C) With respect to Applicant's second argument, the Examiner respectfully submitted that He relied upon the clear teaching of Hardy (See Hardy, Abstract; Col.2, line 67 to Col.3, line 33; Fig.5 and Fig.8; Col.8, lines 63-68 to Col.9, line 16) which correspond to Applicant's claimed feature. Therefore, Applicant argument is not persuasive and the rejection is hereby sustained.

(D) With respect to Applicant's third argument, the Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention.

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

(i) obviousness does not require absolute predictability;

(ii) non-preferred embodiments of prior art must also be considered; and
(iii) the question is not express teaching of references, but what they would suggest. Therefore, Applicant's arguments are non-persuasive and the rejection is hereby sustained.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nanel Frenel/

Examiner, Art Unit 3687

January 13, 2009

/Matthew S Gart/

Supervisory Patent Examiner, Art Unit 3687